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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/914,287

.08/23/2001

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53588-0510

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29989

7590

09/20/2007

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EXAMINER

LE, KHANH H

ART UNIT

PAPER NUMBER

3622

MAIL DATE

DELIVERY MODE

09/20/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/914,287	<b>Applicant(s)</b> HONNEF ET AL.	
	<b>Examiner</b> Khanh H. Le	<b>Art Unit</b> 3622	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 June 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 and 23-31 is/are pending in the application.
- 4a) Of the above claim(s) 14, 25, 29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13, 15-19, 23, 24, 26-28, 30 and 31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This Office Action is responsive to the correspondence filed June 25, 2007. The amendment to the Specification has been entered.

Claims 1, 23, 24, 26-28, 30, and 31 are amended. Independent claims 20-22 are cancelled. No claims are added. Hence, claims 1-19, 23-31 are pending of which claims 14, 25 and 29 were previously withdrawn.

Hence claims 1-13, 15-19, and 23, 24, 26-28, 30 and 31 are herein examined. Claims 1, 23, 24, 26, 27, 28-31 are independent.

2. Previous Objections to Specifications: Withdrawn.

3. The previous rejection of Claim 28 is rejected under 35 U.S.C. 112, second paragraph, is withdrawn following Applicant's clarification.

### ***Response to Arguments***

4. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection which follow.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

*A person shall be entitled to a patent unless –*

*(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.*

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**6. Claims 1-3, 7, 8-13, 23, 24, 26-28, 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Walker et al., US 6138106.**

**Independent claims 1, 23, 24, 26-28 and dependent claims 2, 8, and 10:**

**WALKER discloses:**

a method of processing an electronic stored value certificate (abstract, Figures 1, 2 and 5 and associated text) , comprising the steps of:

receiving a request to create an electronic stored value certificate and storing certificate information that identifies a recipient of the certificate, a recipient address, and an amount of the electronic stored value certificate (abstract; Figure 7A-7C);

issuing and activating the electronic stored value certificate (Figures 7A-7C and associated text; e.g. col. 8 line 12-19)

in response to successfully carrying out a purchase transaction that transfers value from an account associated with a purchaser of the electronic stored value certificate to a certificate issuer (Figures 7A-7C , e.g. items 132-136 and associated text: purchaser pays by credit card),

wherein the electronic stored value certificate may be redeemed for goods and services at one or more merchants (abstract; Figures 8A-8C and associated text);

creating and storing a unique identification value for the electronic stored value certificate in association with the certificate information as part of activating the electronic stored value certificate (Figures 7A item 128 and associated text)

wherein the unique identification value is a random value (Figures 7A item 128 and associated text) that is non-negotiable in a commercial credit card network (WALKER 's unique claim code is not used in a commercial credit card network);

wherein the unique identification value is operable for redemption of the electronic stored value certificate at the merchant in a redemption transaction that does not traverse the commercial credit card network (WALKER 's unique claim code is not used in a commercial credit card network) by communication of the merchant with the certificate issuer (col. 6 lines 30-34).

storing an initial face value of the electronic stored value certificate ( Fig 8A; col. 8 lines 47-49);

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determining a new face value by reducing the initial face value of the electronic stored value certificate by a portion of the initial face value in response to receiving information indicating redemption at the merchant of the portion of the initial face value for goods or services, and

storing the new face value of the electronic stored value certificate (Figure 8A-B; col. 9 line 60 to col. 10 line 2)

repeating the steps of determining and storing the new face value in response to successively received redemption information until the new face value of the electronic stored value certificate is zero (col. 10 lines 3-10; “no longer sufficient to purchase another gift” also reads on a zero balance).

(Note: The instant specification discloses tracking the face value but not specifically to a zero balance. Though this may be implied, it is noted Walker discloses as much as the specification.)

**Claim 3:**

Walker discloses the method of claim 1 above and further discloses the gift-giver profile is taken from prior sales data (Fig. 7B item 134, col. 6 lines 34-43).

**Claims 5, 9 and 11:**

Walker discloses the method of claim 1 above and further discloses redemption against many sellers' products (Fig. 5 item 82) and necessary relationships with sellers are established (col. 6 lines 30-34). Implicitly that means remitting by central controller 12 to sellers the value corresponding to their products that gift recipient selects. Which reads on “generating and returning an amount redeemed to a merchant “.

**Claim 7:**

In view of the amended language, the limitations of claim 7 are interpreted as a redemption process by gift recipient wherein recipient information including certificate current balance is updated. As discussed above, Walker discloses the method of claim 1 above and thus discloses all limitations of claim 7.

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**Claim 12:**

Walker discloses the method of claim 1 above and further implicitly discloses selling its own a "merchant-branded" certificate to gift giver.

**Claim 13:**

Walker discloses the method of claim 1 above and further discloses a call center for redemption (col. 9 lines 32-34).

**Independent claim 30:**

The limitations which are common to the independent claims discussed above are disclosed by WALKER as discussed above.

Further, WALKER's central controller 12 dealing with many sellers is in effect a third party certificate issuer (col. 6 lines 30-34).

Further claim 30 is method claim and having a third party issue the certificate does not affect the method in a manipulative sense. In other words the same steps are present i.e. issuing, activating, redeeming whether it is issuing and activating by the third party or not. Ex parte Pfeiffer, 135 USPQ 31 (BdPatApp&Int 1961) held: "[To] be entitled to such weight in method claims, the recited structural limitations therein must affect the method in a manipulative sense and not to amount to the mere claiming of a use of a particular structure, which, in our opinion, is the case here." Here, the third party merely uses the issuing/activating structures, and that does not affect the overall method, thus per Ex parte Pfeiffer, the third party issuer limitation is not given patentable weight.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

*(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to*

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*which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.*

**8. Claims 4-6, 15-19, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over WALKER.**

**Claim 4:**

Walker discloses the method of claim 1 above and further discloses generating and dispatching a electronic mail notification message to the recipient of the electronic stored value certificate that includes a hyperlink that contains the unique identification value so the recipient may view the certificate within a browser (col. 7 lines 56-58; col. 5 lines 27-37). As to a statement, this is interpreted as the current value of the certificate. Walker does not disclose that because its improvement is to hide the gift value. However it taught that disclosing the initial value of the certificate is typical (col. 1 lines 34). Thus in an embodiment where the gift value is intended not to be hidden as in the invention of Walker, it would have been obvious to one of ordinary skill in the art at the time the invention was made (herein a "PHOSITA") to replace Walker's messages to recipient, both initial to apprise of the gift, and subsequent, of selectable gifts based on remaining value of the certificate (col. 10 lines 3-6), with a direct indication of the initial and remaining value, i.e. a statement.

**Claim 6:**

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Walker discloses the method of claim 1 above.

WALKER does not specifically disclose *“applying the electronic stored value certificate to the order by reducing the current value of the electronic stored value certificate to zero and attempting to receive the balance due for the order by carrying out a charge transaction that transfers value from an account associated with the recipient of the electronic stored value certificate to a certificate issuer with which the electronic stored value certificate may be redeemed; restoring the electronic stored value certificate to its previously determined current value in response to failure of the charge transaction.”*

However, WALKER discloses suggesting to recipient to add value by charge card to afford more expensive gifts (col. 9 lines 42-48 and 16-24). Walker also teaches when the funds are not sufficient the purchase is void and the gift certificate previous balance remains (col.10 lines 8-10). Customarily if a charge card payment fails, the purchase would be void too. Thus in case the recipient attempts to add needed value by charge card and fails, it would have been obvious to a PHOSITA to restore the electronic stored value certificate to its previously determined current value as taught by Walker.

#### **Claims 15-17:**

Walker discloses the method of claim 1 above.

However WALKER does not disclose (Claims 15) a condition to redeem a minimum purchase amount ; (claim 16) recipient needs be first time customer ; (claim 17) a condition to buy specified goods and services.

However, Official Notice is taken that it is old and well-known for companies to provide employee rewards or for merchants to provide loyalty values in the form of reward certificates. It would have been obvious to one skilled in the art at the time the invention was made to use the WALKER system as a vehicle to effect providing such loyalty or reward values. It is also well-known to impose conditions, such as the claimed limitations above, usually for co-branding purposes or to promote sales of a sponsoring merchant. Thus it would have been obvious to a PHOSITA to impose the above claimed conditions to the WALKER system to achieve the above co-branding, or sales promotions goals.

#### **Claims 18, 19:**

Walker discloses the method of claim 1 above.

However, WALKER does not disclose taxes, shipping or handling charges added to the purchase total , and “determining whether applying the current value of the electronic stored



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value certificate to the amount of the order results in a balance due for the order, and if so, generating information that prompts the recipient to add value to the certificate."

However, Official Notice is taken that taxes are often added to a purchase price and also it is customary to include shipping and handling charges. Thus when necessary, they obviously would have been added to a Walker's purchase by a PHOSITA.

Further WALKER discloses recipients adding value by charge card when the certificate value is not sufficient for the total purchase price (col. 9 lines 42-48 and 16-24).

Thus, it would have been obvious to a PHOSITA to add the above claimed limitation to Walker, in case adding taxes, shipping or handling charges would exceed the gift value to afford the total purchase.

#### **Independent claim 31:**

The limitations common to independent claims discussed above are disclosed by WALKER as discussed above.

WALKER does not disclose a reseller of the gift certificate.

However, claim 31 is a method claim and having a reseller resell the certificate does not affect the method in a manipulative sense. In other words the same steps are present i.e. issuing, activating, redeeming whether it is issuing and activating by the reseller or not (i.e. no extra steps are claimed in view of the existence of a reseller). Ex parte Pfeiffer, 135 USPQ 31 (BdPatApp&Int 1961) held: "[To] be entitled to such weight in method claims, the recited structural limitations therein must affect the method in a manipulative sense and not to amount to the mere claiming of a use of a particular structure, which, in our opinion, is the case here." Here, the reseller merely uses the issuing/activating structures, and that does not affect the overall method, thus per Ex parte Pfeiffer, the reseller limitation is not given patentable weight.

Further, even in structure claims, it has been held that making parts separable would be obvious "if it were considered desirable for any reason". See In re Dulberg, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961) ("*The claimed structure, a lipstick holder with a removable cap, was fully met by the prior art except that in the prior art the cap is "press fitted" and therefore not manually removable. The court held that "if it were considered desirable for any reason to obtain access to the end of [the prior art's] holder to which the cap is applied, it would be obvious to make the cap removable for that purpose."*). Here the reason for adding a reseller to Walker might be that the reseller performs the task more efficiently or at better costs.

### *Conclusion*

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Walker US 6138106 A discloses Dynamically changing system for fulfilling concealed value gift certificate obligations with varying certificate value (Fig 8A-8c)

Atsmon US 20040031856 A1 discloses gift certificate account balance [0806] reductions

Kelly US 6454648 discloses a progressive prize awarding and redeeming scheme on a network system.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 571-272-6721. The Examiner works a part-time schedule and can normally be reached on Tuesday-Thursday 9:00-6:00.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone numbers for the organization where this application or proceeding is assigned are 571-273-8300 for regular communications and for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-3600. For patent related correspondence, hand carry deliveries

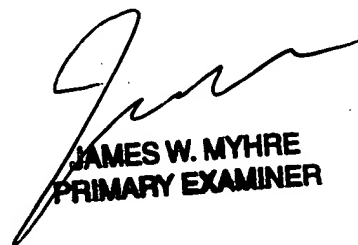
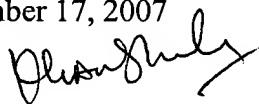
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must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314).

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

September 17, 2007

KHL



**JAMES W. MYHRE**  
**PRIMARY EXAMINER**